

Remarks

Claim 1 has been amended as shown above. Support for the amendments may be found in the written description at, e.g., page 1, lines 19-21, page 2, lines 14-16 and 30-32, page 3, lines 13-16, page 5, lines 7-9, page 7, lines 16-22, page 8, line 26 through page 9, line 10, page 10, lines 22-31 and page 11, lines 3 and 8-24. Following entry of this amendment, claims 1, 3-19 and 36 will be pending in this application.

Applicants thank Supervisory Primary Examiner Chaney for extending to the undersigned attorney the courtesy of an in-person interview on Wednesday, August 16, 2006. The substance of the interview was correctly recorded in the Interview Summary prepared by SPE Chaney at the conclusion of the interview. The interview also involved the amendments shown above and the arguments shown below.

Rejection of Claims 1, 3-19 and 36 under 35 U.S.C. §112

Claims 1, 3-19 and 36 were rejected under 35 U.S.C. §112, second paragraph as being indefinite on grounds that:

“Independent [claim 1 has] been further amended to recite that the “topcoat is “sufficiently strip agent permeable” when “subjected to the action of the strip agent”. There is no antecedent basis for “the strip agent”. How would one skilled in the art determine from the written disclosure, including the examples, which strip agent to use in this instance? Such a recitation in the claims gives rise to uncertainty about the scope of the claims.” (see the Office Action at pages 2-3, numbered paragraph 3).

Reconsideration is requested in view of the above amendment, which recites a “benzyl alcohol” strip agent. The written description discusses a variety of exemplary benzyl alcohol strip agents (see e.g., page 10, line 18 through page 11, line 24), their use (see e.g., page 9, lines 4-20) and their evaluation (see e.g., page 11, line 27 through page 12, line 21). A person having ordinary skill in the art will readily understand the claims. Applicants accordingly request withdrawal of the 35 U.S.C. §112, second paragraph rejection of claims 1, 3-19 and 36.

**Rejection of Claims 1, 3-19 and 36
under 35 U.S.C. §102(b) and Hamrock et al.**

Claims 1, 3-19 and 36 were rejected under 35 U.S.C. §102(b) as being anticipated by Published PCT Application No. WO 98/11168 (Hamrock et al.), on grounds maintained for the reasons of record as stated in the October 5, 2004 Office Action, and on the further grounds that:

*"Applicants traverse the rejection of the rejection of claims 1, 3-19 and 36 under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 9811 1168) and state that claim 1 addresses the coated floor after the topcoat has been applied and before it cures and hardens. However, the Examiner would like to point out that the language recited in independent claim 1 does not preclude the topcoat from being cured and hardened and hence claim 1 recites a coated floor wherein the topcoat is already cured/hardened. Furthermore, in response to the Examiner's position that the use of a two-part composition does not impart distinctive structural characteristics to the final product, Applicants direct the Examiner's attention to the Declaration filed by Robert D. P. Hei under 37 CFR 1.132 and state that the Declaration shows that the vinyl composition flooring tiles coated with a single layer of PADLOCK acrylic polymer floor finish and over coated with a two-component aqueous polyurethane composition exhibited better leveling and hardened finish appearance than the other comparative samples. However, the Examiner would like to point out that even if she agreed that the Hei Declaration shows that with a single layer of PADLOCK acrylic polymer floor finish and over coated with a two-component aqueous polyurethane composition exhibited better leveling and hardened finish appearance **that is not the invention being claimed in the instant application. None of the claims are directed to an invention commensurate in scope with the showing in the Hei Declaration or the Specification.** The Examiner invites the Applicants to amend the claims to recite an invention commensurate in scope with the showing in the Hei Declaration and the*

Specification. A claim reciting a coated floor with a strippable intermediate coating and a mixed two part curable composition is simply not the same as a vinyl floor tile coated with a single layer of PADLOCK acrylic polymer floor finish and over coated with a two-component aqueous polyurethane composition.” (see the Office Action at pages 6-7, emphasis in original).

Reconsideration is requested. As discussed at the Interview, the claim amendments recommended in the Office Action would provide unduly narrow protection. As also discussed, claim 1 is directed to a coated resilient floor before the recited “hardenable waterborne urethane or acrylate overcoat” has dried or otherwise hardened, and is not anticipated by a floor coated with Hamrock et al.’s 100% solids UV-curable composition. Applicants’ attorney also noted at the interview that Hamrock et al. say that UV or visible light polymerizable “resins containing functional polymerizable groups, such as acrylate or vinyl ether/maleate containing an amine or a thiol” are “considered unsuitable for use as floor finishes” (see e.g., page 3, lines 21-28) and thus teach away from at least the use of acrylate overcoats. Applicants accordingly request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1, 3-19 and 36 as being anticipated by Hamrock et al.

**Rejection of Claims 1, 3-19 and 36
under 35 U.S.C. §102(b) and Lauer et al.**

Claims 1, 3-27, 36 and 37 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,932,350 (Lauer et al.), on grounds that:

“Lauer et al. (US 5,932,350) disclose a method for tandem coating substrate, such as cellulosic substrates, with both highly crosslinked thermoset coatings and aqueous based coatings (Column 1, lines 1-9). The substrate may be coated first with the cured coating (ii) and then the highly crosslinked coating (i) which is preferably formed from a thermoset material that is UV curable and which before cure may be a high solids composition or a waterborne composition (Column 2, lines 31-51). The UV curable coatings, after exposure to UV radiation, produce highly crosslinked

coatings. It has proved difficult to adhere water-based topcoats without the use of an intermediate coating (Column 3, lines 1-6). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Lauer et al. given that the chemical composition of the coatings and the structure of the laminate as taught by Lauer et al. and as claimed in the instant application is identical. Furthermore, Lauer's coatings must inherently be strippable "without damaging the floors" given that Lauer teaches the same coatings as claimed by the instant Applicants. All limitations of the claimed invention are either disclosed or inherent in the above reference." (See the Office Action at pages 3-4, numbered paragraph 5)

and on the further grounds that:

"Applicants traverse the rejection of Claims 1, 3-19 and 36 under 35 U.S.C. 102(b) as being anticipated by Lauer et al. (US 5,932,350) and state that Lauer's coatings are "highly cross linked" and are "carbonyl functional" and that Lauer does not state that the coatings "can be stripped without damaging the floors". First, the Examiner would again like to point out that the language of the independent claim does not preclude the topcoat from being "highly cross linked" and/or "carbonyl functional". Second, Lauer's coatings must inherently be strippable "without damaging the floors" given that Lauer teaches the same coatings as claimed by the instant Applicants. Applicants further state that none of Lauer's working examples show a coated floor of the claimed invention. However, "the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain". In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843

(Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994)." (See the Final Rejection at pages 8-9).

Reconsideration is requested. As discussed at the interview, Lauer et al. refer at col. 5, line 50 through col. 6, line 4 to embodiments in which their highly crosslinked coating (i) and waterbased coating (ii) are applied in two different orders. In a first embodiment, the highly crosslinked coating (i) is applied to "cellulosic material, such as wood or paper or a composite material thereof, such as MDF, hardboard, particle board or cardboard" and then overcoated with Lauer et al.'s pigmented waterbased coating (ii) (see e.g., col. 5, lines 50-65). If asked to consider the matter, a person having ordinary skill in the art would conclude that in this embodiment, Lauer et al.'s underlying highly crosslinked coating (i) would be less strippable and more wear-resistant than Lauer et al.'s overcoated waterbased coating (ii). This is the reverse of applicants' claim 1 recitation that applicant's overcoat "is less strippable and more wear-resistant" than applicants' intermediate coating. As discussed at the interview (and as recommended by SPE Chaney), applicants' claim 1 has been amended to recite a "coated resilient floor comprising resilient flooring selected from vinyl flooring, vinyl composite flooring and synthetic sports flooring". If asked to consider the matter, a person having ordinary skill in the art would conclude that "MDF, hardboard, particle board or cardboard" as recited by Lauer et al. are not vinyl flooring, vinyl composite flooring or synthetic sports flooring.

In Lauer et al.'s second embodiment, the waterbased coating (ii) is applied in the form of an ink to "a paper material such as may be typically used in a printing or packaging application" and then overcoated with the highly crosslinked coating (i) (see e.g., col. 5, line

66 through col. 6, line 4). If asked to consider the matter, a person having ordinary skill in the art would conclude that “a paper material such as may be typically used in a printing or packaging application” as recited by Lauer et al. is not vinyl flooring, vinyl composite flooring or synthetic sports flooring.

Applicants do not agree that Lauer et al.’s coatings “must inherently be strippable “without damaging the floors”” as asserted in the Office Action. Lauer et al. say that their coatings are “highly crosslinked” and they cure them using a UV line processor. If asked to consider the matter, a person having ordinary skill in the art would conclude that such a coating could not be stripped without removing a portion of the floor surface (see e.g., page 1, lines 14-22).

Applicants accordingly request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1, 3-19 and 36 as being anticipated by Lauer et al.

**Rejection of Claims 1, 3-19 and 36
under 35 U.S.C. §102(b) and Wang et al.**

Claims 1, 3-19 and 36 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,494,707 (Wang et al.), on grounds that:

“Wang et al. disclose a resilient floor covering comprising of a resilient support surface and a resilient wear surface adhered to said support surface and comprising an underlying wear layer based coat and an overlying wear layer top coat adhered to said wear layer base coat (Column 3, lines 61-68). The wear layer top coat is a hard thermoset UV curable blend of acrylates (Column 4, lines 7-10). The wear layer base coat has a thickness of 0.7 to 3.0 mils and the wear layer top coat has a thickness of 0.1 to 0.5 mils (Column 8, lines 35-45). Conventional substrate layer comprises materials typical of substrate layers found in the flooring art and include vinyl compositions (Column 9, lines 59-66). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Wang et al,

given that the chemical composition of the coatings and the structure of the laminate as taught by Wang et al. and as claimed in the instant application is identical.

Furthermore, Wang's coatings must inherently be strippable "without damaging the floors" given that Wang teaches the same coatings as claimed by the instant Applicants. All limitations of the claimed invention are either disclosed or inherent in the above reference." (see the Office Action at pages 4-5, numbered paragraph 6)

and on the further grounds that:

"Applicants traverse the rejection of Claims 1, 3-19 and 36 under 35 U.S.C. 102(b) as being anticipated by Wang et al. (US 5,494,707) and state that Wang does not teach that the floor can be "be stripped without damaging the floors". However, the Examiner takes the position that Wang's coatings must inherently be strippable "without damaging the floors" given that Wang teaches the same coatings as claimed by the instant Applicants." (See the Final Rejection at page 9).

Reconsideration is requested. As discussed at the interview, Wang et al.'s wear layer top coats appear to be 100% solids UV curable materials (see e.g., col. 9, lines 14-38, Example 5 at col. 16, lines 42-49 and Example 6 at col. 16, lines 64-67). They are described as being useful for manufacturing no-wax flooring (see e.g., col. 4, lines 12-20), and would be understood not to be strippable by persons having ordinary skill in the art. As also discussed at the interview, Wang et al.'s wear layer top coats are not said to be "waterborne" and do not anticipate the rejected claims.

Applicants accordingly request withdrawal of the 35 U.S.C. §102(b) rejection of claims 1 and 3-27 as being anticipated by Wang et al.

Double Patenting Rejection

Claims 1, 3-19 and 36 were provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-7, 11-16, 18 and 19 of copending Application No. 10/821,560.

As discussed at the Interview, this rejection is now moot.

Conclusion

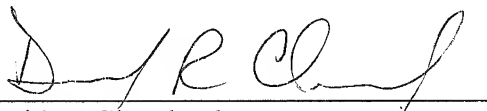
Applicants have made an earnest effort to address the rejections. Applicants have made claim amendments as discussed with SPE Chaney. These amendments should overcome the 35 U.S.C. §112 rejection and should further distinguish Hamrock et al., Lauer et al. and Wang et al. Hamrock et al. use a one-part 100% solids radiation curable overcoat and does not anticipate the rejected claims. Lauer et al. do not show a coated resilient floor comprising vinyl flooring, vinyl composite flooring or synthetic sports flooring and do not anticipate the rejected claims. Wang et al.'s wear layer top coats appear to be 100% solids UV curable materials, not waterborne materials, and Wang et al.'s no-wax floors do not anticipate the rejected claims. The double patenting rejection is now moot.

Withdrawal of the rejections and passage of the application to the issue branch are requested. The Examiner is encouraged to telephone the undersigned attorney at 612-331-7412 to discuss any unresolved questions regarding this application.

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